91-1117

No.

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1991

SOUTHWESTERN BELL TELEPHONE COMPANY,
Petitioner,

vs.

RALPH LANGSTON and EVERGREEN EQUIPMENT, INC.,
Respondents.

Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether to resolve the conflict between the United States Supreme Court and the United States Court of Appeals for the Federal Circuit as to whether finders of fact in patent validity cases and examiners in the United States Patent and Trademark Office must employ the three part test of "non-obviousness" mandated by Section 103 of the Patent Act and *Graham v. John Deere,* 383 U.S. 1 (1966), or a new test which employs a fourth, paramount, extra-statutory consideration, previously described by this Court as "secondary."

2. Whether it is error to instruct a finder of fact that the workmanship of a good mechanic, engineer or chemist skilled in the pertinent art is not invention when the finder of fact is directed, in conformity with Section 103, that "patentability shall not be negatived by the manner in which the invention was made."

RULE 29.1 LIST

Pursuant to Rule 29.1 of the Rules of the Supreme Court of the United States, Southwestern Bell Telephone Company herein sets forth a list of all its parent companies and subsidiaries, exclusive of wholly-owned subsidiaries.

Southwestern Bell Corporation
Southwestern Bell Credit Corporation
Aurec Local Information Services Ltd.
Golden Channels Center (1985) Ltd.
Golden Channels & Company Partnership
PWS Radio, Inc.
Valley Mobile Communications, Inc.

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3 Devitt, Blackmar and Wolff, *Federal Jury Practice and Instructions* (4th ed. 1987), § 97.12 12,14

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Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

The Petitioner, Southwestern Bell Telephone Company, respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit, entered on September 6, 1991, vacating the judgment of the United States District Court for the Eastern District of Missouri and remanding to the latter for proceedings consistent with its opinion.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit has not been reported. It is reprinted in the Appendix hereto, at p. A-1, *infra.*

A judgment was entered on a jury verdict by the United States District Court for the Eastern District of Missouri on January 16, 1990. A copy of the verdict and judgment is reprinted in the Appendix hereto, at p. A-7, *infra*.

JURISDICTION

The judgment of the Court of Appeals for the Federal Circuit was entered September 6, 1991. The Court of Appeals denied the petition for rehearing on October 8, 1991. A copy of the order denying Southwestern Bell Telephone Company's Petition for Rehearing is reprinted in the Appendix hereto, at p. A-9, *infra*. Petitioner's suggestion for rehearing *en banc*, filed on September 20, 1991, was declined on January 2, 1992, and is reprinted in the Appendix hereto, at p. A-15, *infra*. The jurisdiction of this Court to review the judgment of the Federal Circuit is invoked under 28 U.S.C. § 1254(1).

STATUTE INVOLVED

35 U.S.C. § 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the

invention was made, owned by the same person or subject to an obligation of assignment to the same person.

STATEMENT OF THE CASE

Southwestern Bell Telephone Company ("SWBT") operates a telephone communications system servicing Arkansas, Kansas, Missouri, Oklahoma and Texas. To this end, SWBT has installed fiberoptic cable in underground conduit throughout these states.

Ralph Langston and Evergreen Equipment, Inc. (collectively "Langston"), claim to hold patents on a method and apparatus involved in pulling fiberoptic cable through underground conduit.

On March 18, 1986, Langston was issued United States Patent No. 4,576,362 (the '362 Patent) on a method of pulling fiberoptic cable through underground conduit using a series of intermediate capstan assists and end-pulling winches. The second patent, United States Patent No. 4,669,705 (the '705 Patent), covering the mechanical apparatus (an intermediate capstan assist winch) and system (collectively "apparatus") used in practicing Langston's method of pulling fiberoptic cable, issued on June 2, 1987.

On July 10, 1986, prior to receipt of the '705 Patent, Langston filed suit against SWBT in the United States District Court for the Eastern District of Missouri, invoking jurisdiction under 28 U.S.C. § 1338. Langston alleged that SWBT's use of intermediate assist capstans (manufactured by non-party A.B. Chance) to pull fiberoptic cable through underground conduit infringed the '362 Patent. Following receipt of the '705 Patent, Langston amended his complaint to assert that SWBT's use of A.B. Chance capstans also infringed the '705 Patent. SWBT denied infringement and further asserted that the inventions claimed in both the '362 and '705 Patents were invalid as "obvious" under 35 U.S.C. § 103 and thus not patentable.

The problem Langston claimed to have solved with his inventions was how to pull fiberoptic cable underground over long distances without exceeding the maximum allowable pulling force and minimum bending radius of the cable. The claimed inventions call for placing a powered capstan in manholes between the entry and exit points of the cable route. The cable is wrapped around each intermediate capstan and is pulled continuously without being handled.

The novel feature Langston claimed for his inventions was that the capstan winches "sensed" each other, *i.e.*, they kept the pulling force below a predetermined level. SWBT's evidence was that the "sensing" between the capstans was a long-known application of the capstan principle and a mechanical feature of any series of capstans. SWBT offered several prior art references to the jury, three of which involved the use of a series of intermediate powered capstans to pull fiberoptic cable. The principal difference between this art and the claimed invention is that two references did not call for wrapping the cable completely around the capstan and the third reference, while utilizing one or more complete wraps of cable, regulated the cable tension by having a worker pull the cable off each intermediate capstan into a "slack loop." The evidence was disputed as whether it would have been obvious to a person of ordinary skill in the relevant art to combine the powered intermediate capstans of the first two references with the complete wrap of cable around the capstan of the third.

Langston introduced evidence of what he claimed were secondary considerations of non-obviousness, including a long-felt need for the claimed inventions, praise of the inventions by others, commercial success, copying and skepticism that the claimed inventions would truly pull cable safely. SWBT disputed each of these asserted indicia. For example, Langston's commercial success was virtually nil. He offered licenses to the entire cable industry for only $3,000 each but not one was

purchased. Langston's principal evidence at trial regarding copying involved an intermediate-assist puller made by A.B. Chance Company from off-the-shelf parts. Much of Langston's evidence of "praise by others" was excluded as irrelevant because it was praise of another's device — not Langston's claimed inventions.

The case was tried to a jury for eleven days. The jury heard and considered the conflicting evidence on the issue of obviousness. The district court instructed the jury that it *must* consider Langston's evidence of secondary considerations, but told them that such evidence was not controlling apart from their evaluation of the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of skill in the pertinent art. App. at p. A-11. After lengthy deliberations, the jury returned a verdict in favor of SWBT finding that the claimed inventions were invalid as obvious.

On January 16, 1990, the district court entered judgment for SWBT consistent with a jury verdict rendered October 6, 1989, finding Langston's patents invalid as obvious.[1]

On appeal, the United States Court of Appeals for the Federal Circuit found the jury was erroneously instructed on the issue of obviousness, vacated the judgment of the district court and remanded for proceedings consistent with its Opinion. The Court of Appeals held that it was error for the district court to instruct that secondary considerations of non-obviousness are not determinative of the question of obviousness apart from the statutory requirements of 35 U.S.C. § 103. App. at p. A-3. In essence, the Court of Appeals held that the jury should have been

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[1] The district court initially entered judgment for SWBT on October 6, 1989. On motion of SWBT, the judgment of October 6, 1989 was vacated and an amended judgment was entered on January 16, 1990 to reflect that the jury had found Langston's patents invalid.

permitted to decide whether or not to determine the issue of obviousness based solely on secondary considerations. The Court of Appeals found additional error elsewhere in the instruction, including the suggestion that "secondary considerations" were inherently unable to rise to the level of importance accorded the three principal considerations of Section 103. App. at p. A-4.

REASONS FOR GRANTING THE WRIT

I.

A. The test for "non-obviousness" at issue herein affects every patent application and virtually every patent validity suit.

The Federal Circuit's decision below is in direct conflict with Section 103 of the Patent Act and this Court's landmark decision in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). *Graham* set forth the test for obviousness under 35 U.S.C. § 103, a crucial determination in every United States Patent and Trademark Office examination and virtually every patent validity suit. *Graham* mandates an evaluation of the three factual inquiries of obviousness enunciated in § 103. *Graham* also provides that a number of "secondary considerations" also may be relevant in determining whether a claimed invention is obvious and thus non-patentable. 383 U.S. at 17. The United States Court of Appeals for the Federal Circuit has now abandoned *Graham* by holding herein that a jury's or patent examiner's determination of obviousness may be controlled by secondary considerations apart from the three recognized statutory factors. The opinion of the Federal Circuit thus changes the basic analysis of obviousness employed by courts, patent practitioners and the Patent and Trademark Office for over twenty-five years.

This Court should grant review to resolve the conflict between this Court's and the Federal Circuit's respective interpretations of Section 103 of the Patent Act. This is an issue of paramount significance to the patent application process and to the patent and trial bars. Heretofore, patent examiners and practitioners have been able to compare a new invention to readily available, objective evidence of the prior art to assess the non-obviousness, and thus the patentability of the new invention. Under the Federal Circuit's newly announced test, practitioners and examiners bear the additional, impossible burden of locating and

assessing sales data for a new invention, industries' "feelings" about the need for the new invention, expressions of "skepticism" about the feasibility of the new invention and whether others have allegedly copied all or part of the new invention. The Federal Circuit's opinion adds an extraordinary new, extra-statutory burden to a critical legal process designed to "bring out" invention.

For the reasons set forth below, this Court should grant review to consider and correct the Federal Circuit's inappropriate and unmanageable interpretation of Section 103 of the Patent Act and return the patent examiners' and patent trial juries' analysis of obviousness to the three criteria established by Congress and this Court.

B. Though this Court has consistently applied the test for obviousness enunciated in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Federal Circuit has changed the test to require reliance on secondary considerations.

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), this Court for the first time interpreted Section 103 of the Patent Act of 1952, 35 U.S.C. § 103. The Court held that Section 103 requires the finder of fact to make three basic factual inquiries when deciding whether a patent should be deemed invalid as "obvious". The finder of fact must determine (1) "the scope and content of the prior art"; (2) the "differences between the prior art and the claims at issue"; and (3) "the level of ordinary skill in the pertinent art." 383 U.S. at 17.

This Court also stated that non-technical factual matters, characterized as "secondary considerations," might be utilized when determining the obviousness of an invention. These include commercial success of the claimed invention; long felt but unresolved need for the claimed invention; and the failure of others to achieve the results the claimed invention accom-

plished. This Court explicitly noted that these secondary considerations are "indicia of obviousness" which "may have relevancy" in serving as evidentiary details giving "light to the circumstances surrounding the origin of the subject matter" of the patent. 383 U.S. at 17. However, this Court has never even suggested, as the Federal Circuit now holds, that these secondary considerations could supplant the three-part statutory analysis.

In the twenty-five years since *Graham*, this Court has consistently applied the requirements of its three-part test in reviewing obviousness determinations. In *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57 (1969), this Court reiterated the *Graham* holding, noting that " 'strict observance' of those requirements is necessary." 396 U.S. at 62. This Court also affirmed the limited significance of secondary considerations such as commercial success and the satisfaction of a long felt need, stating that "those matters 'without invention will not make patentability.' " 396 U.S. at 61.

In *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), this Court held that the Fifth Circuit Court of Appeals had improperly applied *Graham* and found the patent at issue to be invalid as obvious. *Id.* at 280. This Court affirmed that commercial success and accomplishment of a desired result in a faster and less expensive way, in and of themselves, cannot support a finding that the claimed invention was not obvious. *Id.* at 282-83. In *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986), this Court quoted with approval the exact language from *Graham* setting forth both the three-part test for obviousness and the limited evidentiary role secondary considerations are to play in the determination of obviousness. 475 U.S. at 810-811.

The Federal Circuit, even given its special expertise in the area, is nevertheless bound by the decisions of this Court. It is not free to renounce or alter Supreme Court decisions because the "precedent of this Court must be followed by the lower federal

courts no matter how misguided the judges of those courts think it to be." *Hutto v. Davis*, 454 U.S. 370, 375 (1982). This Court has said that it will not overrule or modify its own precedent construing the patent statutes without "a clear and certain signal from Congress" that such a change is warranted. *Deepsouth Packing Co. v. The Laitram Corp.*, 406 U.S. 518, 531 (1972). No such signal has been issued by Congress.[2]

Despite the binding force of *Graham*, the Federal Circuit has altered this Court's three-part test by expanding the role of secondary considerations in the obviousness determination so that these secondary considerations have been elevated to the equal of the three primary statutory considerations of § 103.[3] Moreover, by virtue of the Federal Circuit's decision herein, in

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[2] Since *Graham*, Section 103 of the Patent Act of 1952 has undergone no material change. The only revision of note in the past twenty-five years was enacted in 1984 and provides:

> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This amendment does not bear upon the weight to be given secondary considerations in an obviousness determination. Further, no other provision of the patent laws evidences an intent to alter the obviousness requirements.

[3] In a recent decision, the Federal Circuit upheld the grant of a summary judgment of obviousness. *Ryko Mfg. Co. v. Nu-Star, Inc.*, App. No. 91-1065 (Fed. Cir. Dec. 4, 1991). The court based its decision on the fact that the district court considered all evidence before it, including secondary considerations. The Federal Circuit stated that such a decision may be made by the district court "as long as the secondary considerations are contemplated by the court." *Ryko*, at 12. Despite this language, the Court noted that its decision did not weaken its previous declarations that "secondary considerations are not secondary in importance to primary considerations." *Ryko*, at 13.

some circumstances, secondary considerations may control the obviousness inquiry apart from the primary statutory considerations.

In its first term, the Federal Circuit held that secondary considerations *must* be part of the obviousness determination because such considerations "may often be the most probative and cogent evidence in the record." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). Later, the Federal Circuit reiterated that secondary considerations must be considered, as they may be the most "pertinent, probative, and revealing evidence available to *aid* in reaching" an obviousness determination. *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 851 (1984) (emphasis added). Secondary considerations may tend to "reassure the decision maker" and "can often serve as insurance against the insidious attraction of the siren hindsight when confronted with a difficult task of evaluating the prior art." *Id.* at 1553.

The following year, the court classified secondary considerations as "simply indicia of non-obviousness." *Leinoff v. Louis Milona & Sons, Inc.*, 726 F.2d 734, 740 (Fed. Cir. 1984) *cert. denied*, 474 U.S. 843 (1985). However, the court stated that while secondary considerations may help determine whether a claimed invention is obvious, they were "not *necessarily* conclusive." *Id.* (emphasis added).

Despite the progression of decisions expanding the role of secondary considerations, the Federal Circuit consistently recognized that these considerations could not control the obviousness determination. In 1985, the Federal Circuit was presented compelling evidence of a claimed invention with a strong impact on the industry, which enjoyed commercial success and which fulfilled a long felt need. Nonetheless, the court held that secondary considerations did not overcome the strong case of obvious-

ness established by the principal considerations. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898 (Fed. Cir. 1985). *See also, Newell Companies, Inc. v. Kenney Mfg, Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988) (Secondary considerations "do not control the obviousness determination.").

C. The Federal Circuit's holding that secondary considerations may control the obviousness determination is in direct conflict with this Court's decision in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The decision below marks the Federal Circuit's departure from the test of obviousness enunciated in *Graham*. Not only did the court hold that it was error to instruct a jury that secondary considerations are indeed "secondary", but it also suggested that evidence of commercial success, praise by others of the claimed invention and the like (previously thought to be mere "indicia" of obviousness) could overcome a finding of obviousness supported by the three basic factual inquiries into the prior art required by § 103 and *Graham*. In adding its own unauthorized gloss to the Patent Act, the Federal Circuit expressly disapproved of a pattern jury instruction closely following *Graham*.

The focus of the decision below was upon Instruction No. 19 by which the district court submitted the obviousness issue to the jury. App. at p. A-11. Instruction No. 19 directed the jury to make the three basic factual inquiries required under the Patent Act and *Graham*. 383 U.S. at 17. The district court told the jury that it *must* utilize the evidence presented by the Plaintiff regarding secondary considerations "to reflect light upon the circumstances surrounding the origin of the subject matters sought to be patented." App. at p. A-11. However, the Federal Circuit found erroneous the further direction to the jury that its inquiry into secondary considerations was "relevant to the issue of obviousness, *but not determinative thereof apart from the three basic factual inquiries*". App. at p. A-3. (Emphasis added).

The instruction was in all material respects the suggested form instruction set forth in § 97.12 of 3 Devitt, Blackmar and Wolff, *Federal Jury Practice and Instructions* (4th ed., 1987)[4], a text widely used by trial lawyers as a guide to formulating proposed jury instructions, except that it told the jurors they "must," rather than "may," utilize secondary considerations in reaching their verdict.[5]

The Federal Circuit's decision impermissibly altered the obviousness test set forth by this Court in *Graham*. The court criticized Instruction No. 19 for describing the secondary considerations as "inherently unable to rise to the same level of importance as the other 'factual inquiries' listed by the court." App. at p. A-4. The court thus held that relegating these secondary considerations to less than primary status was now incorrect. In light of this opinion, the test for obviousness according to the Federal Circuit is now truly a four-part inquiry into: (1) the scope and content of the prior art; (2) the difference between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations of nonobviousness.

The decision below further suggested that secondary considerations may be of overriding importance, thereby allowing the jury to disregard the three basic factual inquiries because "evidence of the secondary considerations may often be the most

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[4] The full text of § 97.12 of 3 Devitt, Blackmar & Wolff is reprinted in the Appendix hereto, p. A-13, *infra*.

[5] The use of the word "must" in Instruction No. 19 actually increased the importance of secondary considerations beyond that found in the pattern instructions and the actual language of *Graham*. This modification assured that secondary considerations were part of the jury's consideration and that the Federal Circuit's post-*Graham* precedents were honored.

probative and cogent evidence in the record . . . [establishing] that an invention appearing to have been obvious in light of the prior art was not." App. at p. A-__. This is in direct conflict not only with this Court's holding in *Graham* that a three-part test is to be applied, but also with the Federal Circuit's own precedent regarding the role of secondary considerations in an obviousness determination. *See, W.L. Gore & Associates*, 721 F.2d at 1540; *EWP Corp.* 755 F.2d at 898.

Graham v. John Deere Co., 383 U.S. 1 (1966) has been neither altered nor overruled by this Court since it was decided twenty-five years ago. The Court has repeatedly quoted with approval the exact language of *Graham* which is set forth in Instruction No. 19. The Court has never suggested, as the Federal Circuit now holds, that "secondary considerations" are anything but secondary. *E.g., Dennison Mfg Co. v. Panduit Corp.*, 475 U.S. 809 (1986).

The Federal Circuit's decision elevates "secondary considerations" to a fourth, primary consideration which (unlike any of the three *Graham* considerations) may be determinative of obviousness. However, the factors which this Court has labeled as "secondary considerations" are just that — secondary. There is no reason to believe that this Court meant otherwise. The Federal Circuit's decision, which permits the elevation of secondary considerations from secondary to paramount status, is plainly contrary to *Graham* and the Patent Act itself.

II.

The Federal Circuit's decision also criticized the "workmanship of a good mechanic" language in Instruction No. 19 because § 103. "makes clear that '[p]atentability shall not be negatived by the manner in which the invention was made.'" This criticism also represents a departure from Supreme Court precedent. The latter quotation from § 103 is found in the first paragraph of

Instruction No. 19. The "workmanship" language, copied verbatim from § 97.12 of Devitt, Blackmar & Wolff, has a distinguished lineage from *Graham* to *Hotchkiss v. Greenwood*, 11 How. 248, 13 L.Ed. 683 (1851) to Thomas Jefferson. *See, e.g., Graham*, 383 U.S. at 7-12. This Court held that the 1952 Patent Act made "no change" in the test to be applied and that "the standard has remained invariable in this Court." 383 U.S. at 19. Again, the decision below ignored this Court's mandate from *Graham*.

CONCLUSION

The Federal Circuit's decision is in direct conflict with this Court's holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Elevating secondary considerations to primary status is contrary to the Patent Act and this Court's obviousness test first announced in *Graham*. While *Graham* remains this Court's definitive statement on patent obviousness, if the decision of the Federal Circuit is allowed to stand, finders of fact will have broad license to ignore the analysis required by *Graham* and by Congress in § 103 in favor of "secondary considerations" never before deemed sufficient to determine the obviousness of the claimed invention apart from the primary considerations of obviousness. Moreover, patent examiners will have to consider not only the claimed invention and the prior art, but also subjective, extrinsic details of the claimed invention's commercial success, industry's perceived need for the invention, and alleged praise and copying of the invention. These are plainly inquiries never contemplated by Congress or this Court.

For the foregoing reasons, Southwestern Bell Telephone Company respectfully requests that this Court issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered in this case on September 6, 1991.

Respectfully submitted,

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January 6, 1992

APPENDIX

APPENDIX A

NOTE: Pursuant to Fed. Cir. R. 47.8, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

90-1229

RALPH LANGSTON and
EVERGREEN EQUIPMENT, INC.,
Plaintiffs-Appellants,

v.

SOUTHWESTERN BELL TELEPHONE COMPANY,
Defendant-Appellee.

DECIDED: September 6, 1991

Before PLAGER, *Circuit Judge*, SMITH, *Senior Circuit Judge*, and LOURIE, *Circuit Judge*.

PLAGER, *Circuit Judge*.

DECISION

Plaintiffs-appellants Ralph Langston and Evergreen Equipment, Inc. (Langston) appeal from a judgment of the United States District Court for the Eastern District of Missouri, *Langston v. Southwestern Bell Tel. Co.*, No. 86-1395C(3) (Jan. 16, 1990) in favor of defendant-appellee Southwestern Bell Telephone Co. (Southwestern Bell). Based on the jury verdict, the court ruled that claims 4, 5, 6, 10, 11, and 13 of the U. S. Patent No. 4,576,362 and claims 1 and 2 of U. S. Patent No. 4, 669,705 were invalid. We *vacate* and *remand*.

DISCUSSION

A.

Langston contends, *inter alia*, that the district court erred in its instructions to the jury and that the errors were prejudicial. We review jury instructions to determine whether there was prejudicial legal error. *Jamesbury Corp. v. Litton Indus. Prod., Inc.*, 756 F.2d 1556, 1558, 225 USPQ 253, 255 (Fed. Cir. 1985). As Southwestern Bell correctly notes, in ruling on the adequacy of jury instructions we read the instructions as a whole and consider them in the light of the entire charge to the jury. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1582-83, 1 USPQ2d 1081, 1093-94 (Fed. Cir. 1986). Only if the purported error in the instructions affects the substantial rights of the parties should we order a new trial. Fed. R. Civ. P. 61.

Langston argues in particular that jury instruction No. 19 misstated the test for determining obviousness under 35 U.S.C. § 103 (1988).[1] Jury instruction No. 19 states, in relevant part:

> To determine obviousness or nonobviousness, consideration must be given to such factual inquiries as:
>
> 1. Scope and content of the prior art;
>
> 2. Differences between the prior art and the claims at issue;
>
> 3. The level of ordinary skill in the pertinent art.

---

[1] In its brief to the court, Southwestern Bell notes that Instruction No. 19 was taken from Section 97.12 of 3 Devitt, Blackmar & Wolff *Federal Jury Practice and Instructions* (4th ed. 1987) [hereinafter Devitt, Blackmar]. We did not compare the instructions given by the trial judge to the cited text, so that no assessment of the correctness of the text instructions is intended. *But see infra* note 2.

> Such [secondary]* considerations as commercial success or lack thereof; long felt but unresolved needs; failure of others and other similar facts must be utilized by the jury to reflect light upon the circumstances surrounding the origin of the subject matters sought to be patented.
>
> Inquiry into these considerations is relevant to the issue of obviousness, but not determinative thereof apart from the three basic factual inquiries mentioned above.

Joint Appendix at 132. Instruction No. 19, in addition to being somewhat abstruse, fails to accurately describe the role of secondary considerations in an obviousness determination.

> Obviousness under 35 U.S.C. § 103 is a legal conclusion involving a preliminary determination of four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. Secondary considerations include objective indicia of nonobviousness such as commercial success, long-felt but unsolved need, and failure of others.

Uniroyal, Inc. v. Rudkin-Wiley Corp, 837 F.2d 1044, 1050, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988) (citations omitted). Evidence of secondary considerations is not to be given short shrift. As this court has said,

> evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been

---

* *Petitioner's note: The word "secondary" did not appear in the instruction given to the jury. See App. at A-11.*

> obvious in light of the prior art was not. It is to be considered as part of all the evidence. . . .
>
> ***
>
> Enroute to a conclusion on obviousness, a court must not stop until *all* pieces of evidence on that issue have been fully considered and each has been given its appropriate weight.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983). In the present case, the praise given by others, the long felt and unsolved need, the failure by others and the alleged copying of the Langston inventions are all strong indicia of nonobviousness. Yet, instruction No. 19 presents these secondary considerations as inherently unable to rise to the same level of importance as the other "factual inquiries" listed by the court. This is incorrect.

This court has previously indicated the desirability of obtaining specific answers from the jury on the factual issues underlying an obviousness determination. *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1517, 220 USPQ 929, 939 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984). While it is not error to submit the question of obviousness to a jury in the form of a general verdict, when that is done it is essential that "the submission [is] accompanied by appropriate instructions on the law from the trial judge." *Id.* at 1514-15, 220 USPQ at 937-38. In this case, the significant body of evidence of secondary considerations presented to the jury in combination with the error in jury instruction No. 19 regarding how the jury was to evaluate these secondary considerations was clearly prejudicial to Langston.

B.

Instruction No. 19 included a statement that "workmanship of a good mechanic, or engineer or a [*sic*] chemist skilled in the pertinent art is not invention." *Joint Appendix* at 132. This

instruction is erroneous. The relevant issue is patentability, not "invention" and § 103 makes clear that "[p]atentability shall not be negatived by the manner in which the invention was made.

> What controls the patentability of the fruits of the inventor's labors are the statutory conditions of novelty, utility, and unobviousness "to a person having ordinary skill in the art to which said subject matter pertains" as stated in § 103.

Kimerbly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1454, 223 USPQ 603, 614 (Fed. Cir. 1984). Further, the instruction erroneously suggests that where the work of a mechanic or engineer of ordinary skill in the art is involved, then, in some manner, such involvement weighs against a jury finding that a patentable invention was made. Because the Langston inventions were based heavily on both mechanical and engineering skills, this instruction was prejudicial to Langston.

Langston cites other problems with Instruction No. 19, including the way in which the jury was instructed regarding when prior art references can properly be combined. Instruction No. 19 fails to instruct the jury that "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Langston points also to problems with other instructions, some of greater substance than others. For example, Instruction No. 9 fails to inform the jury that the burden of proving invalidity is on Southwestern Bell and that the standard of proof is that of clear and convincing evidence. *See Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d at 1517, 220 USPQ at 939. Instead, Instruction No. 9 speaks of clear and convincing evidence only in terms of actions of the Patent and Trademark Office in issuing the patent. Instruction No. 9 also speaks of each claim constituting "an advance". This is not a requirement of patentability and

the instruction is erroneous. *See* 35 U.S.C. §§ 101. Instruction No. 18 is also in error.[2] Novelty does not hinge on the results achieved by the invention. Novelty, under 35 U.S.C. § 102, is a question of the identity of the invention with that in a single prior art reference. *See, e.g., Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983). Further, because no § 102 issue remains in this case, this instruction is at best irrelevant and quite possibly prejudicial.

We are left with the indelible impression, reading the jury instructions as a whole as we must, that they did not provide the jury with the guidance required to correctly assess the evidence before it, and that this failure was substantially prejudicial to Langston. Based on these errors, the judgment of invalidity is vacated and the case remanded for proceedings consistent with this opinion.

COSTS

Costs to Langston.

---

[2] Southwestern Bell notes that Instruction No. 18 "faithfully followed the proposed instruction at Section 97.11 of [Devitt, Blackmar]."

APPENDIX B

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

No. 86-1395C(3)

RALPH LANGSTON, et al.,
Plaintiffs,

v.

SOUTHWESTERN BELL TELEPHONE COMPANY,
Defendant.

JUDGMENT

The issues in this case having come on for trial before the Court, the Honorable William L. Hungate, District Judge, presiding; the issues having been duly tried in part by the Court sitting without a jury, and in part by the Court sitting with a jury; and a decision and a verdict having been rendered,

IT IS HEREBY ORDERED AND ADJUDGED that defendant Southwestern Bell Telephone company take nothing by its patent misuse and inequitable conduct defenses, and plaintiffs Ralph Langston and Evergreen Equipment, Inc., may seek to enforce the patents at issue in this case.

IT IS HEREBY FURTHER ORDERED AND ADJUDGED that plaintiffs Ralph Langston and Evergreen Equipment, Inc., take nothing by their cause of action against defendant Southwestern Bell Telephone Company; that claims 4, 5, 6, 10, 11, and 13 of United States Patent Number 4,576,362, and claims 1 and 2 of United States Patent Number 4,669,705 are invalid; and that defendant Southwestern Bell Telephone Company recover of the plaintiffs Ralph Langston and Evergreen Equipment, Inc.,

defendant Southwestern Bell Telephone Company's costs of action.

EYVON MENDENHALL, CLERK

By /s/ Florence H. Guzenski
Deputy Clerk

Dated this 16th day of January,
1990, at St. Louis, Missouri.

Approved as to form this 16th day
of January, 1990.

/s/ William L. Hungate
UNITED STATES
DISTRICT JUDGE

APPENDIX C

United States Court of Appeals for the Federal Circuit

90-1229

RALPH LANGSTON and
EVERGREEN EQUIPMENT, INC.,
Plaintiffs-Appellants,

v.

SOUTHWESTERN BELL TELEPHONE COMPANY,
Defendant-Appellee.

ORDER

Before PLAGER, Circuit Judge, SMITH, Senior Circuit Judge, LOURIE, Circuit Judge.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

The mandate will issue on October 15, 1991.

FOR THE COURT,

/s/ Francis X. Gindhart
Clerk

Dated: October 8, 1991

cc: WILLIAM I. RUTHERFORD
BRADLEY A. WINTERS

LANGSTON V SOUTHWESTERN BELL, 90-1229
(DCT - 86-1395C(3)

Note: Pursuant to Fed. Cir. R. 47.8, this order is not citable as precedent. It is a public record.

APPENDIX D

INSTRUCTION NO. 19

The test of obviousness to be applied by the jury in considering the validity of each of the patents here in issue is to determine if "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." Patentability, however, shall not be negated by the manner in which the invention was made.

To determine obviousness or nonobviousness, consideration must be given to such factual inquiries as:

1. Scope and content of the prior art;

2. Differences between the prior art and the claims at issue;

3. The level of ordinary skill in the pertinent art.

Such considerations as commercial success or lack thereof; long felt but unresolved needs; failure of others and other similar facts must be utilized by the jury to reflect light upon the circumstances surrounding the origin of the subject matters sought to be patented.

Inquiry into these considerations is relevant to the issue of obviousness, but not determinative thereof apart from the three basic factual inquiries mentioned above.

Thus, workmanship of a good mechanic, or engineer or a chemist skilled in the pertinent art is not invention.

Knowledge of the prior art is not limited to knowledge of the public generally, nor to those who carry on routine work in a complex and technical field. The expected skill of the

art embraces the knowledge of experts, scientists, and trained engineers who have been working in the art.

Determining obviousness may be accomplished by picturing a hypothetical person of ordinary skill in the pertinent art in a room with all of the relevant prior art. If the apparatus and method defined in the claims of the patents would naturally occur to this person, then the claimed invention is obvious, and the patents are therefore invalid.

APPENDIX E

3 Devitt, Blackmar and Wolff, *Federal Jury Practice and Instructions* (4th ed., 1987), § 97.12

§ 97.12 Obviousness Defined

The test of obviousness to be applied by the jury in considering the validity of each of the patents here in issue is to determine if "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which subject matter pertains." Patentability, however, shall not be negated by the manner in which the invention was made.

To determine obviousness or non-obviousness, consideration must be given to such factual inquiries as:

1. Scope and content of the prior art;

2. Differences between the prior art and the claims at issue;

3. The level of ordinary skill in the pertinent art.

Such considerations as commercial success, or lack thereof, long felt but unresolved needs; failure of others and other similar facts might be utilized by the jury to reflect light upon the circumstances surrounding the original of the subject matter sought to be patented.

Inquiry into these considerations is relevant to the issue of obviousness, but not determinative thereof apart from the three basic factual inquiries mentioned above.

Thus, workmanship of a good mechanic, or engineer or a chemist skilled in the pertinent art is not invention.

Knowledge of the prior art is not limited to knowledge of the public generally, nor to those who carry on routine work in a complex and technical field. The expected skill of the art embraces the knowledge of experts, scientists, and trained engineers who have been working in the art.

Determining obviousness may be accomplished by picturing a hypothetical person of ordinary skill in the pertinent art in a room with all of the relevant prior art. If the machine (process) defined in the claims of the patent in suit would naturally occur to this person, then the claimed invention is obvious, and the patent is therefore invalid.

APPENDIX F

Note: Pursuant to Fed. Cir. R. 47.8, this order is not citable as precedent. It is public record.

United States Court of Appeals for the Federal Circuit

No. 90-1229

LANGSTON V. SOUTHWESTERN BELL

DC-86-1395C(3)

ORDER

A suggestion for rehearing in banc having been filed in this case, and a response hereto having been invited by the court and filed,

UPON CONSIDERATION THEREOF, it is

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, declined.

FOR THE COURT,

/s/ Francis X. Gindhart
Clerk

Dated: January 2, 1992

cc: WILLIAM I. RUTHERFORD
BRADLEY A. WINTERS

Supreme Court, U.S.
FILED
FEB 5 1992
OFFICE OF THE CLERK

(2)

No. 91-1117

IN THE

Supreme Court of the United States

OCTOBER TERM, 1991

SOUTHWESTERN BELL TELEPHONE COMPANY,
Petitioner,

vs.

RALPH LANGSTON and EVERGREEN EQUIPMENT, INC.,
Respondents.

Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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No. 91-1117

IN THE

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Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT OF THE CASE

In its statement of the case, Petitioner, Southwestern Bell Telephone Company ("Southwestern Bell"), has erroneously asserted that the only issue before the Federal Circuit was the jury instruction concerning obviousness — Instruction No. 19. Petition at 5. However, Respondents raised several trial errors on appeal concerning other jury instructions and evidentiary rulings. The Federal Circuit held that the jury instructions, including Instruction No. 19, *read as a whole,* were incorrect and "substantially prejudicial to Langston." Petitioner's Appendix

("Pet. App.") at A-6. The Federal Circuit did not reach the other trial errors raised by Respondents.

Southwestern Bell failed to mention that the Federal Circuit held that Instruction No. 19 was erroneous because it did not instruct the jury that obviousness cannot be established by combining prior art references, absent some teaching or suggestion in the art to support the combination. Pet. App. at A-5.

In addition to Instruction No. 19, the Federal Circuit addressed Instruction Nos. 9 and 18. Instruction Nos. 9 and 18 are reprinted in Respondents' Appendix A and B, respectively. The Federal Circuit held that Instruction No. 9 was prejudicially erroneous because it misstated the burden of proving patent invalidity. Pet. App. at A-5, 6. The Court found that Instruction No. 18 was prejudicially erroneous because it instructed on the defense of novelty which was not in the case and it misstated the law of novelty.

Contrary to Southwestern Bell's assertions (Petition at 5-6), the Federal Circuit did not hold that the jury should have been instructed to determine the issue of obviousness based solely on secondary considerations. The Court merely held that it was error to instruct the jury that secondary considerations are less important than the other factual inquiries in the obviousness determination. Pet. App. at A-4.

In its statement of the case, Southwestern Bell has selectively recited and misstated the objective evidence of nonobviousness presented at trial. As the Federal Circuit held, Respondents, Ralph Langston ("Langston") and Evergreen Equipment, Inc. ("Evergreen"),[1] presented a "significant body of evidence of secondary considerations" to the jury which was strong evidence of nonobviousness. Pet. App. at A-4.

---

[1] Pursuant to Supreme Court Rule 29.1, Evergreen states that it has no parent companies or subsidiaries.

Langston's inventions relate to a method and apparatus for installing long runs of fiber optic cable in underground conduit, through the use of capstan winches placed at intermediate locations along the conduit. During the 1980's, the use of fiber optic cable was growing rapidly throughout the United States and it was being placed in underground conduit on a regular basis by telephone companies and others in the communications industry.

Conventional copper wire cable is installed in underground conduit by passing rope or tape through the conduit and pulling the cable using tension forces of several thousand pounds. Fiber optic cable is much more efficient and economical than conventional wire cable, but it is much more difficult to install in underground conduit. It lacks the tensional strength of wire cable and it will fracture at a much lower pulling tension. Fiber optic cable manufacturers typically specify a maximum pulling tension in the magnitude of 600 pounds. Fiber optic cable is also relatively inflexible. It consists of fine glass fibers bundled in a spiral fashion around a stiff steel support wire within a hard plastic protective sheath. Bending the cable beyond a limited range can damage or break the fibers within. Splicing the fibers effectively is extraordinarily costly and greatly reduces signal strength.

Langston's method and apparatus is safer and more economical than any method or apparatus that came before it. Langston's inventions permit the installation of cable several miles long under circumstances in which: (1) the cable is never pulled at any point greater than a preset maximum pulling force on each winch because the winch will stop pulling when the maximum pulling force is reached; (2) the cable is never bent beyond the minimum bending radius; and (3) the winches automatically coordinate with each other, eliminating the need for humans to handle the cable as it comes off each winch.

At trial, Southwestern Bell admitted that no single prior art reference anticipated Langston's inventions. It was undisputed that no prior art device or method allowed for the cable to be pulled with several hundred pounds of force without the need for humans to handle the cable at each intermediate assist location.

At trial, Respondents presented substantial evidence — which was virtually unrebutted by Southwestern Bell — with respect to the objective (secondary) considerations of nonobviousness that have been recognized by this Court and by the Federal Circuit — *i.e.*, commercial success, copying, long-felt but unresolved need, failures of others and praise by others in the industry.

The evidence showed that for approximately two years before Langston's inventions, people in the telephone industry had been looking for a method for pulling long runs of fiber optic cable without the need for humans to handle the cable. In 1984 — several months after the date of Langston's invention — Southwestern Bell worked with its equipment supplier, A.B. Chance Company ("A.B. Chance"), to develop an intermediate assist puller that would eliminate the need for humans to handle the cable. A.B. Chance unsuccessfully worked on this project from February, 1984 through August, 1984. It was not until A. B. Chance saw the Langston device being used with the now patented method that A.B. Chance was able to build a successful prototype. The A.B. Chance assist puller was identical to the Langston device and method. A.B. Chance began marketing this device and method which was adopted by Southwestern Bell and touted to the other regional Bell operating companies as a method that Southwestern Bell claimed to have perfected.[2]

Southwestern Bell relied on a combination of elements from two prior art devices to argue that the Langston patents were

---

[2] Southwestern Bell is one of the five regional Bell operating companies created in the breakup of AT&T, effective on January 1, 1984.

obvious. The first was a device designed by the Siemens Company in Germany. The undisputed evidence showed that this device was a commercial failure. It was unable to pull cable with more than 110 pounds of force. Siemens built only a few of these machines and was unsuccessful in selling them in the United States.

The other alleged prior art method was devised by the New England Telephone Company. This method required a workman at each intermediate assist location to handle the cable as it came out of the manhole, went around a powered wheel attached to a truck and was manually guided back into the manhole. After this lawsuit was filed, some of Southwestern Bell's crews reluctantly began using a method similar to the New England Telephone method so as to avoid infringement of the Langston patents.

SUMMARY OF ARGUMENT

The Petition for a Writ of Certiorari should be denied because the issues concerning the obviousness instruction (Instruction No. 19) raised in the petition are not determinative of this case. The Federal Circuit held that Instruction No. 19 was prejudicially erroneous for reasons not discussed by Southwestern Bell and the Federal Circuit held that two other jury instructions (Instruction Nos. 9 and 18) were prejudicially erroneous requiring a new trial. Additionally, there are other trial errors which were not reached by the Federal Circuit which would have to be considered by this Court if Certiorari were granted.

Moreover, the Federal Circuit's holding in this case is completely consistent with this Court's precedent and with the precedent of the Federal Circuit and its predecessor court. Contrary to Southwestern Bell's assertions, the Federal Circuit did not hold that the jury should have been instructed to decide the obviousness issue based solely on secondary considerations.

The Federal Circuit merely held that the jury must be correctly instructed that secondary considerations should not be given short shrift and should be considered along with all other evidence concerning obviousness.

The Federal Circuit also correctly held that jury instruction No. 19 was erroneous because of the language concerning "the workmanship of a good mechanic, engineer or chemist."

ARGUMENT

I. The Petition For A Writ Of Certiorari Should Be Denied Because The Issues Concerning The Obviousness Instruction (Instruction No. 19) Raised In The Petition Are Not Determinative Of This Case In That The Federal Circuit Held That Instruction No. 19 Was Also Erroneous Because It Failed To Instruct The Jury That Obviousness Cannot Be Established By Combining Prior Art References Without Some Teaching Or Suggestion To Support The Combination, And The Federal Circuit held That Two Other Jury Instructions Were Also Prejudicially Erroneous; And There Are Other Trial Errors Which Were Not Reached By The Federal Circuit Which Would Have To Be Considered By This Court If Certiorari Were Granted.

The Federal Circuit's decision was based on the jury instructions read as a whole, not only on the obviousness instruction (Instruction No. 19) addressed by Southwestern Bell. Southwestern Bell has not even discussed the Federal Circuit's correct holding that Instruction No. 19 was prejudicially erroneous because it failed to instruct the jury that obviousness cannot be established by combining elements from prior art references, absent some teaching or suggestion in the art to support the combination. Pet. App. at A-5. This has long been the law as stated by the Federal Circuit. *See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, *cert. denied*, 488 U.S. 825 (1988).

Southwestern Bell also has not discussed the Federal Circuit's holding that Instruction Nos. 9 and 18 were prejudicially erroneous, requiring a new trial. The Federal Circuit correctly held that Instruction No. 9 was prejudicially erroneous because it misstated the burden of proving patent invalidity and it spoke of each claim constituting an "advance." Pet. App. at A-5. The Court

held that Instruction No. 18 was also prejudicially erroneous because it instructed on the defense of novelty which had been abandoned by Southwestern Bell and it erroneously stated that novelty depends on the results achieved by the invention rather than whether there is identity between the invention and a single prior art reference. Pet. App. at A-5, 6.

Even if this Court were to grant the Petition for a Writ of Certiorari on the grounds raised by Southwestern Bell, this case would still have to be remanded for a new trial because of the other trial errors found by the Federal Circuit which were not addressed by Southwestern Bell.

Moreover, Respondents raised several other trial errors on appeal which the Federal Circuit did not reach, but would have to be considered by this Court if Certiorari were granted. For example, despite the fact that the District Court had previously dismissed Southwestern Bell's equitable defense that Langston had committed a fraud before the patent office, the District Court erroneously allowed Southwestern Bell to present evidence concerning this issue and argue this issue to the jury. The District Court erroneously excluded from evidence testimony and documents showing lavish praise of the invention including a trade magazine article written by a Southwestern Bell employee. Additionally, despite the substantial evidence of copying and praise of the invention, the District Court refused to instruct the jury that evidence of copying and praise must be considered as objective evidence of nonobviousness.

II. The Petition For A Writ Of Certiorari Should Be Denied Because The Federal Circuit's Opinion Concerning Instruction No. 19 On Obviousness Is Consistent With The Opinions Of This Court, And With Prior Opinions Of The Federal Circuit And Its Predecessor Court.

As stated above, contrary to Southwestern Bell's assertions, the Federal Circuit did not hold that the jury should have been instructed to decide the obviousness issue based solely on secondary considerations. The Federal Circuit merely held that the jury must be correctly instructed that secondary considerations should not be given short shrift and should be considered along with all other evidence concerning obviousness. Pet. App. at A-4.

As early as *Smith v. Goodyear Dental Vulcanite*, 93 U.S. 486, 494-96 (1877), this Court recognized the importance of secondary considerations such as a long-felt but unsatisfied need for a solution to a problem, and the contemporaneous professional recognition of an invention's value. This Court reaffirmed the importance of secondary considerations in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), where it stated:

> These legal inferences or subtests do focus attention on economic and motivational rather than technical issues and are, therefore, more susceptible of judicial treatment than are the highly technical facts often present in patent litigation. See Judge Learned Hand in *Reiner v. I. Leon Co.*, 285 F.2d 501, 504 (2d Cir. 1960). See also Note, Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity, 112 U.Pa.L.Rev. 1169 (1964). Such inquiries may lend a helping hand to the judiciary which, as Mr. Justice Frankfurter observed, is most ill-fitted to discharge the technological duties cast upon it by legislation. *Marconi Wireless Telegraph Company of America v. United States*,

> 320 U.S. 1, 60, 63 S. Ct. 1393, 87 L.Ed. 1731 (1943). They may also serve to "guard against slipping into use of hindsight," *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (1964), and to resist the temptation to read into the prior art the teaching of the invention in issue.

Graham, 383 U.S. at 35-36.

In *United States v. Adams*, 383 U.S. 39 (1966) — a case decided on the same day as *Graham v. John Deere* — this Court relied primarily on the objective evidence of nonobviousness in finding that the Adams invention was not obvious. This Court stated:

> We have seen that at the time Adams perfected his invention noted experts expressed disbelief in it. Several of the same experts subsequently recognized the significance of the Adams invention, some even patenting improvements on the same system.

Adams, 383 U.S. at 52.

Southwestern Bell erroneously asserts that the Federal Circuit has created some new test which puts an undue burden on practitioners and patent examiners to assess "sales data for the new invention, industries' 'feelings' about the need for the new invention, expressions of 'skepticism' about the feasibility of the new invention and whether others have allegedly copied all or part of the new invention." Petition at 7-8.[3] However, this is, and always has been, part of the test for determining obviousness.

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[3] Southwestern Bell is mistaken in its assertion that the Federal Circuit's opinion will affect every patent application and patent validity suit. Petition at 7-8. Pursuant to Federal Circuit Rule 47.8, the Federal Circuit's unpublished decision — correct as it is— is not citable as precedent. *See* Pet. App. at A-1.

To determine whether the patents were obvious, the jury had to determine whether the differences between the subject matter of the patents "and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103 (emphasis added). It is far too easy for a lay jury to review prior art references, compare them with the patent at issue, and assume erroneously that since the prior art and the patent are similar, the differences would have been obviousness to one of ordinary skill in the art at the time of the invention. Many inventions, however, while appearing obvious several years after they are made and have been put into everyday use, were not obvious to those working in the art at the time of the invention. It is inappropriate to find obviousness based on a hindsight reconstruction of the invention. *Graham*, 383 U.S. at 36; *Gillette Co. v. S.C. Johnson, Inc.*, 919 F.2d 720, 726 (Fed. Cir. 1990) (Rich, J.).

Southwestern Bell's primary evidence of obviousness was the testimony of its expert, a patent lawyer with no skill or experience in the relevant art. The only objective evidence the jury could look at to determine what one of ordinary skill in the art would have thought to be obvious at the time of the invention was evidence of what those in the art thought, said and did with respect to this invention and with respect to prior attempts to solve the same problem. Considering these historical facts — as opposed to the present views of an "expert" — is the only way the jury could "guard against slipping into use of hindsight." *Graham*, 383 U.S. at 36.

The evidence in this case showed that others in the industry, including Southwestern Bell's supplier, A.B. Chance, had unsuccessfully attempted to solve the problem of pulling long runs of fiber optic cable in underground conduit. Once Langston's inventions were disclosed to the public, they were immediately copied and praised by others in the industry, including Southwestern Bell itself.

After hearing this evidence, the jury was told in Instruction No. 19 that they "must" consider objective evidence, but this evidence was not determinative apart from the other three *Graham* inquiries. Pet. App. at A-11. As the Federal Circuit correctly held, this instruction improperly gave objective evidence short shrift and made it less important than the other factual inquiries. Pet. App. at A-3, 4.

The Federal Circuit's decision in this case was completely consistent with its previous opinions and those of its predecessor court — the Court of Customs and Patent Appeals — which have held, on numerous occasions, that objective evidence of nonobviousness, when present, must always be considered equally with the other elements of the *Graham* test. The Federal Circuit has often referred to the test for determining obviousness as a four-part test. *See, e.g., Gillette Co.*, 919 F.2d at 725; *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 963 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 305-06 (Fed. Cir. 1985), cert. denied*, 475 U.S. 1817 (1986); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556-57 (Fed. Cir. 1985); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983); *Stevenson v. International Trade Commission*, 612 F.2d 546, 553-54 (CCPA 1979); *In re: Mageli*, 470 F.2d 1380, 1382-83 (CCPA 1973); *see also* 2 Chisum, *Patents*, Section 5.05 (1984), and cases cited therein. "The objective evidence of secondary considerations may in any given case be entitled to more or less weight, depending upon its nature and its relationship to the merits of the invention." *Ashland Oil, Inc.* , 776 F.2d at 306; *Mageli*, 470 F.2d at 1383.

Relying upon *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), Southwestern Bell argues that secondary considerations are less important than, and should not be given as much consideration as, the other elements of the *Graham* test. Petition

at 9. These cases merely hold, however, that secondary considerations do not necessarily prove nonobviousness.

The Federal Circuit and its predecessor court have previously addressed the very argument made by Southwestern Bell and rejected it. For example, in *Stevenson, supra*, after considering this Court's opinion in *Sakraida*, the Court of Customs and Patent Appeals rejected the infringer's argument that secondary considerations can only tip the scales in favor of patentability in close cases. *Stevenson*, 612 F.2d at 553. The Court held:

> The inference of obviousness drawn from prior art disclosures is only prima facie justification for drawing the ultimate legal conclusion that the claimed invention is obvious under 35 U.S.C. § 103. Therefore, it is necessary that such secondary considerations also be evaluated in determining the final validity of that legal conclusion.

Id.; *see also Mageli*, 470 F.2d at 1382-83.

Similarly, in *Fromson*, the Federal Circuit held that the trial court erred by reaching a determination of obviousness without first considering the objective evidence of nonobviousness. 725 F.2d at 1556-57. The Federal Circuit went on to hold:

> Requiring consideration of all evidence probative of a question is not the same as requiring that particular evidence must be controlling. Nor is such a requirement inconsistent with language appearing in *Anderson's-Black Rock, supra*. Objective evidence ("secondary considerations"), such as commercial success due to the merits of the invention, must when present be considered as part of the obviousness equation.

Id. at 1557.

In the present case, the Federal Circuit merely cited its prior opinions and held that it was error to instruct the jury that secondary considerations are less important than the other factual inquiries of *Graham v. John Deere*. This is anything but a change in the law. It is completely consistent with the opinions of this Court and with the patent law as it has existed in this country for over 25 years.

III. The Federal Circuit Correctly Held That Instruction No. 19 Was Erroneous Because Of The Language Concerning "The Workmanship Of A Good Mechanic, Engineer or Chemist."

Southwestern Bell argues that the Court of Appeals erred by criticizing the sentence in Instruction No. 19 which stated "the workmanship as a good mechanic, engineer or a chemist skilled in the pertinent art is not invention." Petition at 14-15. As the Federal Circuit explained, this instruction erroneously suggested that invalidity can be shown if the work of a mechanic or engineer of ordinary skill in the art is involved in making the invention. Pet. App. at A-5. Indeed, this phrase in Instruction No. 19 is a *non sequitur*. The workmanship of a good mechanic or engineer may well be patentable, if it meets the requirements of patentability. Indeed, all inventions, by definition, are derived from the workmanship of someone skilled in the pertinent art. The Federal Circuit's holding on this issue was correct.

CONCLUSION

For the foregoing reasons, Respondents Evergreen and Langston respectfully request this Court to deny Southwestern Bell's Petition for a Writ of Certiorari.

Respectfully submitted,

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APPENDIX

APPENDIX A

INSTRUCTION NO. 9

The granting of a patent by the United States Patent Office carries with it the presumption that the patent is valid. That is to say, it is presumed that each new claim is new and useful and constitutes an advance which was not, at the time the invention was made, obvious to one of ordinary skill in the art to which the invention relates. The law presumes, in the absence of clear and convincing evidence to the contrary, that the Patent Office acted correctly in issuing the patent.

This presumption of validity puts the burden of proving invalidity on the defendant.

APPENDIX B

INSTRUCTION NO. 18

The three basic elements requisite to a patent are:

First: Novelty — the invention should disclose something "new:"

> In order to be "new," as that word is used in the patent laws, the achievement must be either one that produces an unusual or improved or advanced result, which was unknown to the same prior art at the time of the claimed invention; or the achievement must be one that produces an old result in an unusual or substantially more efficient or more economical way.

If a single prior art reference discloses each and every element of the claim, there is no novelty.

Second: Utility — the invention should be useful:

> In order to be "useful", as that word is used in the patent laws, the achievement must have practical application or utility in the same art — that is to say that the achievement will operate or function in the manner claimed and produce a useful result calculated by the invention.

Third: Nonobviousness - the subject matter of the invention must not be "obvious" to a person having ordinary skill in the pertinent art at the time the invention was made.

Thus, novelty, utility and nonobviousness which add or contribute to the sum of useful knowledge are inherent requisites in a patent in order for it to promote progress of the useful arts.